

**REMARKS**

Applicants appreciate the Examiner's thorough review of the present application, and respectfully request reconsideration in light of the preceding amendments and the following remarks.

Claims -8, 10-11 and 13-21 are pending in the application. Claims 1 and 16 have been amended to better define the claimed invention. New claims 19-21 have been added to provide Applicants with the scope of protection to which they are believed entitled. The amended/new claims find solid support in the original application, e.g., FIG. 4 at 523, 524, and FIG. 5, as well as the corresponding text in the specification. No new matter has been introduced through the foregoing amendments.

The Examiner's observation regarding the Declaration is noted. However, no correction is deemed necessary in light of the USPTO's recent policy set forth in attached *Exhibit A*. (Note the framed text).

The *35 U.S.C. 112, first paragraph* rejection of claim 17 is noted. Applicants respectfully submit that claim 17 finds support in the original application at least as indicated in attached *Exhibit B* which is an annotated version of FIG. 8. Withdrawal of the *35 U.S.C. 112, first paragraph* rejection is now believed appropriate and therefore respectfully requested.

The new art rejections are noted. Although Applicants do not necessarily agree with the Examiner's position, amendments have nevertheless been made solely for the purpose of expediting prosecution. In particular, independent claim 1 now recites, among other things, a bill guide plate that has a plurality of openings for dropping foreign matter separated from the bill, and partition members arranged within the openings for partitioning each of the openings into a plurality of small openings." A person of ordinary skill in the art would understand that by providing such partition members, it is possible to control the size of the small openings, and hence, the size of foreign

matter that can be dropped through the small openings to the collecting container below, so that such size-controlled foreign matter will not get inside the cabinet to cause any undesired effects on the operation of various devices of the gaming machine. None of the applied references appear to fairly teach or suggest the added claim feature and/or achieve the above-discussed advantage. Therefore, amended independent claim 1 is patentable over the applied art of record.

The dependent claims, including the new claims, are considered patentable at least for the reasons advanced with respect to independent claim 1.

As to claim 16, Applicants respectfully submit that the *Vogt* element 12/10 is not a container because it does not allow the foreign matter to be collected therein. In fact, all applied references teach away from the claimed container, disclosing only elements that allow the foreign matter to be drained away, rather than contained therein. See, for example, hole 30/32 at the bottom of element 10 in FIG. 3 of *Vogt* or opening C in FIG. 5 of *Watanabe*. To further distinguish from the references, Applicants have amended claim 16 to define a container having a completely closed bottom for containing the foreign matter received through the opening of the upper narrowed portion. None of the applied references teach or suggest the added feature, and therefore, amended claim 16 is patentable over the art.

As to claims 19-20, the claimed features, i.e., “the partition members are configured to prevent a coin usable with the gaming machine from passing through the small openings of the bill guide plate and being collected in the container” and “a length of each of the small openings is formed to be smaller than a diameter of the coin” are advantageous in that they prevent coins used with the gaming machine, which might be accidentally dropped on the bill guide plate, from passing through the bill guide plate and becoming unnecessarily lost. Another advantage is that foreign matter of sizes smaller than the coins can still be dropped from the inserted bills and prevented from entering the cabinet. None of the applied references teach or suggest the added feature, and therefore, claims 19-20 are patentable over the art.

It should be further noted that it would not have been obvious to modify the applied references to include the claimed features because the configuration of the bill guide slot in *Watanabe* (16 in FIG. 3 of *Watanabe*) and *Vogt* (126 in FIG. 1 of *Vogt*) already prevents coins from accidentally entering the bill guide slot. Therefore, preventive features as claimed in claims 19-20 would be unnecessary in the machines of *Watanabe* and *Vogt*, and hence, would not have been incorporated by a person of ordinary skill in the art in the Examiner's combination of the references.

As to claim 21, none of the applied references fairly teach or suggest the claim features that "the bill guide plate has an open bottom part that has an inclined peripheral wall; and the guide part also has an open bottom part that also has an inclined peripheral wall." An advantage of the claimed invention has been disclosed in the specification, at the sentence bridging pages 7-8. No such advantage can be deemed obtained in the applied references, and therefore, claim 21 is patentable over the art.

Each of the Examiner's rejections has been overcome. Accordingly, Applicants respectfully submit that all claims are now in condition for allowance. Early and favorable indication of allowance is courteously solicited.

Serial No. 10/696,584

The Examiner is invited to telephone the undersigned, Applicant's attorney of record, to facilitate advancement of the present application.

Respectfully submitted,

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**Duty of Disclosure Language Set Forth in Oaths or Declarations  
Filed in Nonprovisional Patent Applications**

**Summary:**

The United States Patent and Trademark Office (Office) will no longer accept as complying with 37 CFR 1.63(b)(3) an oath or declaration that does not acknowledge a duty to disclose information material to patentability as defined in 37 CFR 1.56. All oaths or declarations filed on or after June 1, 2008, will be required to include the language expressly set forth in 37 CFR 1.63, including that in 37 CFR 1.63(b)(3). This notice applies to oaths or declarations filed in all nonprovisional patent applications, including reissue applications.

**Background:**

Current 37 CFR 1.63 sets forth the requirements for an oath or declaration filed in a nonprovisional patent application. 37 CFR 1.63(b)(3) sets forth what the person making the oath or declaration must state when acknowledging the duty of disclosure. Specifically, 37 CFR 1.63(b)(3) requires persons making an oath or declaration to state that they acknowledge their duty to disclose to the Office all information known to the person to be "material to patentability as defined in § 1.56." This language is incorporated in: 37 CFR 1.153, which sets forth the requirements for an oath or declaration in a design application; 37 CFR 1.162, which sets forth the requirements for an oath or declaration in plant patent applications; and 37 CFR 1.175 which sets forth the requirements for an oath or declaration in a reissue application.

In 1992, the Office amended 37 CFR 1.63 to conform to amendments made in 37 CFR 1.56. See Duty of Disclosure, 57 FR 2021 (January 17, 1992) (final rule). The amendments to 37 CFR 1.63(b)(3) resulted in "material to patentability as defined in § 1.56" replacing "material to the examination of the application in accordance with § 1.56(a)." Despite this amendment to 37 CFR 1.63(b)(3), some applicants in their oaths or declarations continue to use "material to the examination of the application" in place of "material to patentability," and "in accordance with § 1.56(a)" in place of "as defined in § 1.56." In response to proper objections made during the examination of pending patent applications, practitioners have argued that the oaths and declarations executed by applicants with the outdated language in question are proper and meet the requirements set forth in 37 CFR 1.63 in view of Comment 38 and the accompanying Reply in the 1992 Final Rule. See Duty of Disclosure at 2027. Additionally, these practitioners have argued that the outdated language should be accepted because the Office has not routinely enforced strict compliance with current 37 CFR 1.63, as evidenced by the number of pending patent applications and issued patents containing oaths or declarations with the outdated "material to examination" and "in accordance with 37 CFR 1.56(a)," language.

**Revised Procedure:**

With this Notice, the Office is putting applicants and their representatives on notice that compliance with the express language of 37 CFR 1.63 will now be required. Additionally, to the extent the Reply to Comment 38 in the 1992 Final Rule authorized the continued use of the "material to examination" and "in accordance with 37 CFR 1.56(a)," language, this authorization is hereby rescinded, and reliance on the Reply to Comments 38 will no longer be accepted. If an oath or declaration filed on or after June 1, 2008, does not include the express language set forth in 37 CFR 1.63(b)(3), the Office will object to the oath or declaration as failing to comply with 37 CFR 1.63. A supplemental oath or declaration pursuant to 37 CFR 1.67 will then be required.

For pending applications, the Office is hereby *sua sponte* waiving the express language requirement of 37 CFR 1.63(b)(3), where the oath or declaration was filed prior to June 1, 2008. The express language of 37 CFR 1.63(b)(3) is waived only to the extent necessary such that an oath or declaration containing the "material to examination" or "in accordance with § 1.56(a)" language, or both, will be accepted as acknowledging the applicant's duty to disclose information "material to patentability" as defined in 37 CFR 1.56.

For continuing applications filed under 37 CFR 1.53(b), other than continuation-in-part applications, the Office will accept an oath or declaration that contains the outdated language if the oath or declaration otherwise complies with 37 CFR 1.63, and either: (1) was filed prior to June 1, 2008; or (2) is being filed in a continuation or divisional application in which a claim for benefit under 35 U.S.C. 120 has been made to a prior-filed copending nonprovisional application, and the oath or declaration is a copy of the previously accepted oath or declaration that was filed prior to June 1, 2008.

For issued patents, the Office is hereby waiving *nunc pro tunc* the express language requirement of 37 CFR 1.63(b)(3), where the oath or declaration was filed prior to June 1, 2008. As stated above, the express language of 37 CFR 1.63(b)(3) is waived only to the extent necessary such that an oath or declaration containing the "material to examination" or "in accordance with § 1.56(a)" language, or both, will be accepted as acknowledging the applicant's duty to disclose information "material to patentability" as defined in 37 CFR 1.56. Any supplemental oath or declaration filed for an issued patent may simply be placed in the patent application file without review or comment.

While not required, patentees and applicants are free to submit newly executed oaths or declarations with the language expressly set forth in current 37 CFR 1.63(b)(3), in accordance with 37 CFR 1.67.

Applicants are advised that, notwithstanding the waiver in the preceding paragraphs, an applicant who has not disclosed information that is material to patentability as defined in current 37 CFR 1.56, because it was believed that the information was not "material to examination," should disclose such information in order

to discharge the applicant's duty of disclosure as required by 37 CFR 1.56, and should file a supplemental oath or declaration acknowledging that duty of disclosure.

Questions about this notice may be directed to the Office of Patent Legal Administration at (571) 272-7701 or electronic mail message to [PatentPractice@uspto.gov](mailto:PatentPractice@uspto.gov).

Date: 11/22/08

  
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JON W. DUDAS  
Under Secretary of Commerce for Intellectual Property and  
Director of the United States Patent and Trademark Office

## Exhibit B

**Fig. 8**

